



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/063,434	04/23/2002	Yin-Chun Huang	8821-US-PA	4966

43831 7590 12/18/2006

BERKELEY LAW & TECHNOLOGY GROUP
1700NW 167TH PLACE
SUITE 240
BEAVERTON, OR 97006

EXAMINER

GIBBS, HEATHER D

ART UNIT	PAPER NUMBER
----------	--------------

2625

DATE MAILED: 12/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/063,434	Applicant(s) HUANG ET AL.	
	Examiner Heather D. Gibbs	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,4-7 and 11-24 is/are allowed.
- 6) ☒ Claim(s) 2,3 and 8-10 is/are rejected.
- 7) ☒ Claim(s) 2,3 and 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 2-3,9 recite the broad recitation moving said scanning head a second distance in the first direction, wherein said second distance is smaller than said first distance, and

Claim 2 also recites further comprising repeating said scanning, said moving said scanning head, and said repeating, wherein movement of said scanning head alternates between said first direction and a second direction, until said scanning head scans a plurality of portion of said paper sheet and

Claim 3, also recites further comprising repeating said scanning, said moving said scanning head, and said repeating, wherein said moving said scanning head comprises moving said scanning head in a second direction opposite to said first direction, and

Claim 9 also recites repeating said moving the paper sheet, said scanning, said moving said second distance, and said repeating, wherein said scanning head alternates between moving in said first direction and in a second direction, and wherein said second direction is opposite said first direction, which are narrower statements of the range/limitation. Claims 2,3,9 depend from an independent claim which states "repeating said scanning" however the claim further recites "moving said scanning head" in a direction that is not repeating. In order for the claims to be proper, it must still repeat the limitations as cited in independent claims. Currently, the dependent claims are in contradiction to the parent claims.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 8,10 are rejected under 35 U.S.C. 102(b) as being anticipated by Muramatsu (US 5,452,108).

Art Unit: 2625

Regarding claim 8, Muramatsu teaches a method comprising: moving a paper sheet a first direction towards a scanning window (Col 2 Lines 58-63); scanning a portion of said paper sheet with a scanning head (Col 2 Lines 58-63); moving said scanning head to a second distance in a first direction, wherein said second distance is smaller than said first distance and repeating said scanning and said moving said scanning head to scan a plurality of portions of said paper sheet over said scanning window (Col 2 Lines 58-63; Fig 10).

The first distance is the distance a document travels from the original feed tray to the platen glass, and the second distance is each incremental distance the scanner is moved by the motor to scan a line of the document.

For claim 10, Muramatsu discloses wherein the scanning head moves in a scanning direction to scan said paper sheet (Fig 10).

Specification

5. Claims 2-3,9 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 2-3, 9 do not further limit the parent claim in that the repeating step no longer repeats, instead it moves in an alternate direction (alternating, opposite), hence the Examiner finds these claims do not further limit the subject matter as disclosed in its parent claim.

Allowable Subject Matter

6. Claims 1, 4-7, 11-24 are allowed.
7. The following is a statement of reasons for the indication of allowable subject matter: Examiner found neither prior art cited in its entirety, nor based on the prior art, found any motivation to combine any of the said prior art which teaches a method comprising: moving a paper sheet a first distance; scanning a portion of said paper sheet with a scanning head; moving said scanning head a second distance in a first direction, wherein said second distance is smaller than said first distance; scanning another portion of said paper sheet; and repeating said moving the paper sheet, said scanning, and said moving said scanning head to scan a plurality of portion of said paper sheet, respectively, as set forth in Claims 1, 6, 11, 16, 20, including all of the features recited therein.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Chen et al (US 7,136,200) Method for Determining Restored Scanning Position.
9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Heather D. Gibbs whose telephone number is 571-272-7404. The examiner can normally be reached on M-Thu 8AM-7PM.

Art Unit: 2625

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Heather D Gibbs
Examiner
Art Unit 2625

hdg



THOMAS D. LEE